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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,294	11/06/2003	Gerd Ulbers	KEL 008 P2	8082
34232	7590	06/02/2006	EXAMINER	
MATTHEW R. JENKINS, ESQ. 2310 FAR HILLS BUILDING DAYTON, OH 45419			LARYEA, LAWRENCE N	
			ART UNIT	PAPER NUMBER
			3735	
DATE MAILED: 06/02/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,294

Applicant(s)

ULBERS, GERD

Examiner

Lawrence N. Laryea

Art Unit

3735

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/09/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it includes legal phraseology "The inventive", "comprises", "illuminating means" and "said". Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-21, 28, 29 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claim 1, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In the present instance, claim 1 recites the broad recitation device, and the claim also recites slit-lamp unit which is the narrower statement of the range/limitation.
6. With respect to claim 1, it is unclear what "reflections ophthalmoscopically" meant. It is unclear if reflections are coming from the "rear eye section", or internal device component or from the "ophthalmoscopically."
7. Claim 4 and 15 recites the limitation "the deflecting device". There is insufficient antecedent basis for this limitation in the claim.
8. Claim 5,6 and 16 recites the limitation "the illuminating beam". There is insufficient antecedent basis for this limitation in the claim.
9. Claim 7,17-21 and 28 recite the limitation "the device". There is insufficient antecedent basis for this limitation in the claim. It is unclear which "device" the base is connected to.
10. With respect to claim 11 and 32, it is unclear how optical imaging means for imaging the rear eye are positioned "near the eye".

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**12. Claims 1-4,7,11-15,17-19,22-25,28,32 are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al (US 2001/0028441). Okamoto et al teach an ophthalmologic apparatus which comprises of the following:**

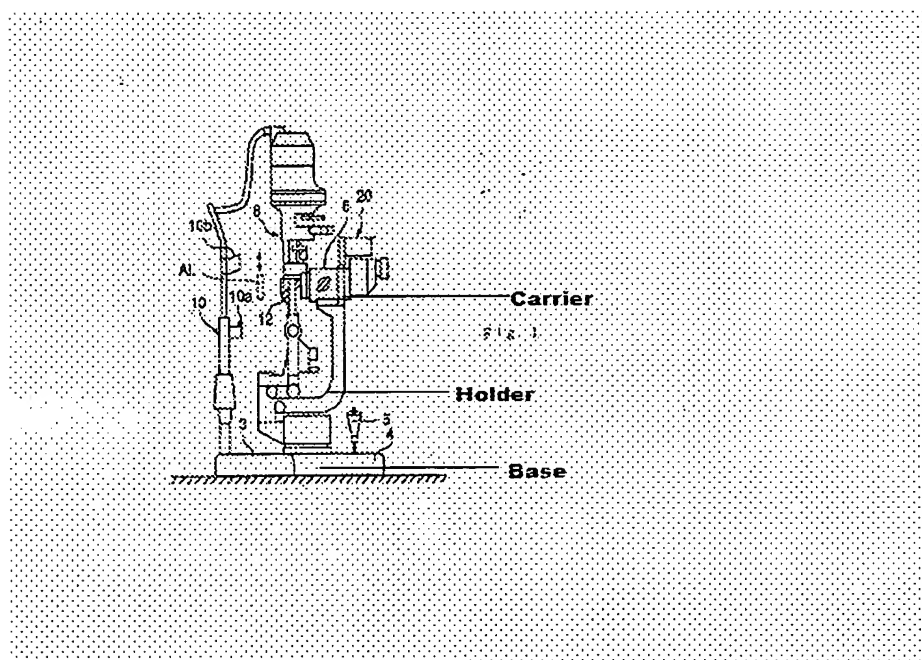
**13. Re Claims 1 and 22:** Okamoto et al teach a device for viewing an eye of a patient, in particular a slit-lamp unit **See paragraph [0015,line 1-2]**, comprising viewing means **See paragraph [0014, line 7-8]** for viewing a front section of the eye and illuminating means **See paragraph [0016,line 1-9]** for illuminating the front section of the eye, characterized in that the illuminating means **See paragraph [0016,line 1-9]** are designed in such a way that it is also possible to illuminate a rear section of the eye **See paragraph [0016,line 1-9]**, and that the device comprises optical imaging means(**See Fig.2, AL**) for imaging the rear eye section, and an image acquisition device(**See Fig.2 unit 20**) for acquiring images of the eye with the aid of an image recording device(**See Fig 1, unit 43**), the image recording device being designed and capable of being positioned such that it is possible thereby to image the rear eye section without reflections ophthalmoscopically.

**14. Re Claims 2 and 23:** Okamoto et al teach that the illuminating means comprise a light source **See paragraph [0016,line 1-9]** for generating an illuminating beam **See paragraph [0016,line 1-9]**, and can be switched over from background illumination to foreground illumination. **See paragraph [0022].**

15. Re Claims 3,13 and 24: Okamoto et al teach that the image acquisition device comprises a deflecting device (**See Fig.2 unit 34**), it being possible to position the deflecting device in front of the eye such that a viewing beam emerging from the eye can be deflected through the image recording device. (**See Fig 1, unit 43**).

16. Re Claims 4, 14,15 and 25: Okamoto et al teach that the illuminating means comprise a light source and form a unit with the image acquisition device, it being possible to deflect a viewing beam generated by the light source onto the eye by the deflecting device (**See Fig 1,12**).

17. Re Claims 7,17,18,19, and 28 : Okamoto et al teach that the image acquisition device comprises a holder with a base and a carrier, the image recording device being fastened on the carrier, the base being connected moveably to the device, and the holder having guide means for displacing the carrier relative to the base. (**See Fig.1**)



18. Re Claims 11 and 32: Okamoto et al teach that the device according to one of claims 1, characterized in that the optical imaging means for imaging the rear eye section are positioned near the eye. **See paragraph [0052] (See Fig.2). The optical imaging means for imaging the fundus are position near the eye.**

19. Re Claims 12 and 33: Okamoto et al teach that the image acquisition device is designed in such a way that it can be switched over between at least two magnifications. **See paragraph [0068]. In the case where the switch is provided, if the front eye portion observation is performed in the switch-off and the eye fundus portion observation is performed in the switch-on, an advantage that the optical parts are necessarily inserted onto the optical axes in the eye fundus portion observation is obtained. See paragraph [0064,line6-7].**

### ***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 8 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Okamoto et al** in view of **Ulbers et al (Patent 6474815)**. **Okamoto et al** disclose the claimed invention except for the guide means being of a rail-type design. **Ulbers et al** teach that it is known to have rail-type design in order for the device to move in the X-

direction to roll on rails forward and backward. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of **Okamoto et al** to include guide means having rail-type design similar to those of **Ulbers et al** to permit the device to move in the X-direction to roll on rails forward and backward so that the front and back portions of the eye may be examined properly as taught by **Ulbers et al (See Col. 6, line 43-57).**

22. Claims 9,10 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Okamoto et al** in view of **Yoshimura et al (Patent 6283596).** **Okamoto et al** disclose the claimed invention except for the image acquisition device comprises an image displaying device that displaying the images acquired by the image acquisition device. **Yoshimura et al** disclose an image acquisition device comprising an image displaying device (242) for displaying the images acquired by the image acquisition device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image acquisition device of **Okamoto et al** including an image displaying device similar to that of **Yoshimura et al** for displaying the images acquired by the image acquisition device in order to examine the cross-section of the anterior segment of eye as taught by **Yoshimura et al (See Fig.1b and Col. 8, line 55-63).** However, **Okamoto et al** and **Yoshimura et al** disclose an image displaying device comprises a photographic camera, a video camera or a CCD camera. **(See Yoshimura et al, unit 58 and Okamoto et al, unit 43,paragraph line 3)**



23. Claims 5,6,16,20,21,26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Okamoto et al** in view of **Freeman et al (Patent 6766042)**.

**Okamoto et al** disclose the claimed invention except for the illuminating beam which can be deflected onto the eye at a variable angle of incidence, the illuminating beam comprising a plurality of annularly arranged individual beams. **Freeman et al** teach an illuminating beam comprises a plurality of annularly arranged individual beams [**Col. 3, line 5-11**] and also an illuminating beam which can be deflected onto the eye at a variable angle of incidence (**see fig 2A**). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the **Okamoto et al** device to use an illuminating beam comprises a plurality of annularly arranged individual beams [**Col. 16, line 9-16**] and also an illuminating beam which can be deflected onto the eye at a variable angle of incidence so that the examination of eye be sufficient and precise as taught by **Freeman et al**.

### ***Conclusion***

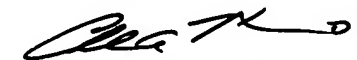
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Akita et al** (US 2005/0195360) disclose a light of a ring shape (pattern) having a plurality of concentric rings deflected onto the eye.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence N. Laryea whose telephone number is 571-272-9060. The examiner can normally be reached on 8:30 a.m.-5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chuck Marmor, II be reached on 571-272- 4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Charles A. Marmor, II  
SPE, Art Unit 3735

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